

# **Exhibit**

# **1**

1 VOL. I, PAGES 1 - 224

2 IN THE UNITED STATES DISTRICT COURT

3 FOR THE DISTRICT MASSACHUSETTS

4 CIVIL ACTION NO. 03-CV2428-WGY

5

6 BRAUN, GmbH

7 Plaintiff

8 V.

9 RAYOVAC CORPORATION ,

10 Defendant

11

12 - - - - -

13 Deposition of Samir Nayfeh, Ph.D.

14 Friday, August 26, 2005

15 8:58 a.m.

16 Ropes & Gray

17 One International Place

18 Boston, Massachusetts

19 - - - - -

20 Reporter: Deborah Roth, RPR/CSR

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ORIGINAL

Dr. Samir Nayfeh August 26, 2005

14

1 design should be able to understand all of these  
2 patents.

3 Q. Okay. I guess that's where I do have some  
4 confusion then.

5 I mean, in particular, the Lee patent,  
6 would that be within the art of the patents-in-suit?

7 A. Could you remind which one is Lee?

8 Q. Tool-cleaning apparatus. Do you have your  
9 second report?

10 MS. WENDLANDT: Page 23 of your second  
11 report, Exhibit 151.

12 A. Oh, okay.

13 So Braun had said that it was not  
14 analogous art.

15 Whether it's analogous for this -- is  
16 there a strict definition of the term "analogous,"  
17 "analogous art," in other words?

18 I haven't really, anywhere in here,  
19 rendered an opinion on it, or really considered it as  
20 a question that I have analyzed.

21 Q. So you haven't considered whether Braun's  
22 argument as to whether it was analogous or not --  
23 analogous art -- well, you do not offer an opinion as  
24 to whether or not the Lee patent is or is not

Dr. Samir Nayfeh August 26, 2005

15

1 analogous art; is that correct?

2 A. Well, I haven't offered an opinion, I don't  
3 think.

4 Q. Let's take a step back to the level of skill  
5 in the art.

6 I guess there may be agreement between  
7 you and Mr. Phillips as to the level of skill.

8 For someone who lacks a formal education,  
9 what type of experience would you expect that  
10 individual to possess?

11 A. I would say, again, experience in mechanical  
12 design.

13 Q. And, again, mechanical design of any  
14 products?

15 A. Yeah. I would say broadly, unless the  
16 person's experience was so narrow as to not provide  
17 them any background in the basic elements of what is  
18 going on here, but I would say typically someone with  
19 a few year's experience in mechanical design would  
20 have enough background to understand what is going on  
21 here.

22 Q. When you say "the basic elements of what is  
23 going on here," what do you mean those basic  
24 elements?

Dr. Samir Nayfeh August 26, 2005

34

1 apparatus?

2 A. No.

3 Q. Why not?

4 A. Shaving is cutting hairs off down to the  
5 skin. Hair clippers don't do that.

6 Q. Have you ever use hair clippers before?

7 A. Yes.

8 Q. And it doesn't shave down to the skin?

9 A. No.

10 Q. So, in your opinion, shavings has to be  
11 cutting down to the skin, that is a shaving  
12 apparatus?

13 A. Yes.

14 Q. I believe it is also your opinion that a hair  
15 clipper is not a dry shaving apparatus as well? That  
16 would be your opinion as well, correct?

17 MS. WENDLANDT: Objection.

18 A. Correct.

19 Q. If you see in Figure 3, there is shown a  
20 razor 42. Do you see that?

21 A. Yes.

22 Q. Is razor 42 a shaving apparatus?

23 A. Yes.

24 Q. Look back to the upper paragraph at the top.

Dr. Samir Nayfeh August 26, 2005

49

1           You would be looking for a device that  
2       dries and is asking the person, the user of the  
3       device to do the drying separately, seems not to fall  
4       within the claims.

5           Q.   And what specific portion of the -- what  
6       specific language in Claim 11 makes it fall outside  
7       of the claims?

8           A.   Well, in other words, your cleaning devices  
9       comprises all of these things.

10           So the towel on the side, I don't see as  
11       part of this cleaning device, and it would just seem  
12       bizarre to claim that it's providing a towel so  
13       somebody would constitute having an invented a drying  
14       device.

15           Q.   So you think it's -- the language that you  
16       are pointing to precludes that the towel hypothetical  
17       is a cleaning device in Claim 11?

18           A.   Well, I think if we said a cleaning device  
19       comprising a set of those elements, and one of those  
20       elements being a drying device, then you would look  
21       for a device that is comprised within the cleaning  
22       device that does the drying.

23           Q.   Are you aware that the parties have agreed  
24       that the preamble to Claim 11 is not a limitation in

Dr. Samir Nayfeh August 26, 2005

50

1 the case?

2 MS. WENDLANDT: Objection.

3 A. Yes. I'm aware of that.

4 Q. So it is your opinion that -- let me ask  
5 again then.

6 What language in Claim 11 specifically  
7 precludes my towel hypothetical?

8 MS. WENDLANDT: Objection.

9 Q. Let me ask again. What language in Claim 11  
10 specifically precludes my towel hypothetical from  
11 falling within the scope of Claim 11's coverage?

12 MS. WENDLANDT: Objection.

13 A. You need a device that is part of the machine  
14 as far as I can tell.

15 The word "device" implies some mechanism,  
16 something, some item and some physical object, and  
17 all of these elements are components of this system,  
18 and to sort of import the function of drying to  
19 something outside of the system itself, I don't think  
20 anybody skilled in the art would ever consider  
21 somebody wiping a towel on the thing after you have  
22 taken it out of the machine to be the drying device.

23 Q. So you ponit me to the word "device" in Claim  
24 11; is that correct?

Dr. Samir Nayfeh August 26, 2005

51

1 MS. WENDLANDT: Objection.

2 A. At least the word "device."

3 Q. Is there any other language that you can see,  
4 sitting here today, that precludes my hypothetical  
5 from falling within the scope of Claim 11?

6 A. I think the word "comprising," whether or not  
7 you consider "a cleaning device comprising" to be a  
8 limitation, I think is meaningful.

9 Q. So, any other language?

10 A. I think that's it for specific language.

11 Q. What if Rayovac began selling its cleaning  
12 base, and also had in a larger box a handheld fan,  
13 and included an instruction book that said, "use this  
14 fan to dry off the head of the shaver after  
15 cleaning," would that fall within the scope of Claim  
16 11?

17 A. No.

18 Q. And why not?

19 A. Repeat of the argument for the towel. Same  
20 principle.

21 You are asking somebody -- you are using  
22 something that is not part of the cleaning device to  
23 do the drying. Whether it is a towel or hair dryer,  
24 it's not important.



Dr. Samir Nayfeh August 26, 2005

53

1 Q. Okay. So that -- the words "a drying device"  
2 don't place any limitation on where the drying device  
3 is; is that correct?

4 MS. WENDLANDT: Objection.

5 A. On their own, no.

6 Q. So with respect to these series of questions  
7 regarding my hypotheticals, the language you would  
8 rely on is "a cleaning device comprising"; is that  
9 correct?

10 MS. WENDLANDT: Objection.

11 A. So, yeah, the cleaning device has to comprise  
12 a drying device in addition to the other elements.

13 Q. Let's just stay on this topic. If you should  
14 turn to Page 18 of your expert report.

15 A. Okay.

16 Q. You speak there, in some detail, regarding  
17 this louvered shutter system; is that correct? It  
18 starts at Page 18 --

19 A. Correct.

20 Q. -- but it continues on.

21 Where in Claims 11 and 12 of the '328  
22 patent do we find this louvered shutter system?

23 A. We don't.

24 Q. So why, then, are you discussing the louvered

Dr. Samir Nayfeh August 26, 2005

54

1 shutter system in connection with obviousness?

2 A. Because when you look at obviousness, you ask  
3 what would it take for the inventors to make this  
4 invention?

5 The inventors couldn't have written the  
6 claim that requires a drying device unless they could  
7 have written a document which would enable one  
8 skilled in the art to incorporate a drying device  
9 into the cleaning system.

10 Q. So absent the louvered shutter system, the  
11 cleaning device with a -- the cleaning system with a  
12 drying device would not work?

13 MS. WENDLANDT: Objection.

14 A. What I was pointing to was that they couldn't  
15 have written that claim unless they had taught you  
16 some means of incorporating the drying device into  
17 the cleaning system.

18 So when you look at obviousness, you  
19 can't just look at the claims. You have to look at  
20 the active invention, and the active invention  
21 includes being able to write the enabling document.

22 Q. What is your understanding of what you are  
23 supposed to be comparing for purposes of the  
24 obviousness analysis?

Dr. Samir Nayfeh August 26, 2005

55

1 A. I don't see it as strictly a comparison.

2 Q. Okay. When you were rendering your opinions  
3 on obviousness, you weren't comparing the claims to  
4 the prior art?

5 MS. WENDLANDT: Objection.

6 A. You're not comparing strictly the claims.

7 You're looking at the claim in the  
8 context of the overall invention and asking whether  
9 the active invention was obvious.

10 Q. And what is the active invention?

11 A. The active invention is conceiving of what is  
12 claimed and enabling what is claimed.

13 Q. So when you were opining on obviousness, you  
14 were considering the claims and the specification  
15 against the prior art; is that right?

16 A. Yes.

17 Q. And did counsel explain to you what you were  
18 supposed to consider in connection with your  
19 obviousness analysis?

20 A. I think when I first wrote this, we hadn't  
21 discussed it, and it's just things that I had learned  
22 in previous experiences.

23 Q. Turn back to Page 4.

24 MS. WENDLANDT: Jim, if this is an okay

1 correct?

2 A. At least that. I don't remember if there is  
3 anything else.

4 Q. There is also the point -- you also mention  
5 the point about the clipper blades, too, and that's  
6 not the shaving head of a shaving apparatus?

7 A. Yes.

8 Q. But one of your opinions, like McKiney and  
9 Davies, is that grid 17 and tank 10 do not have a  
10 particular shape; is that correct?

11 A. Correct.

12 Q. And that's where at the bottom of this  
13 paragraph you say, "Such surfaces cannot properly be  
14 called cradle structures and are not adapted to  
15 receiving a shaving head of the shaving apparatus"?

16 A. Correct.

17 Q. Now, have you -- you've also considered that  
18 the '556 patent in connection with this litigation;  
19 is that correct?

20 A. Yes.

21 Q. And you're aware that the '556 patent  
22 explicitly calls out a dry shaving apparatus; is that  
23 correct?

24 A. Yes.

Dr. Samir Nayfeh August 26, 2005

79

1 Q. And are you also aware that the '328 patent  
2 does not explicitly require a dry shaving apparatus?

3 A. Yes.

4 Q. And with respect to the drying device element  
5 of the Maatz patent at the bottom of this page --

6 A. Yes.

7 Q. -- your opinion is that the drain hole 22 is  
8 not a drying device; is that correct?

9 A. Correct.

10 Q. If you took the drain hole 22 out of the --  
11 well, if you plug the drain hole 22 in the Maatz  
12 patent, would it take longer for the cleaned tools to  
13 dry?

14 A. Yes.

15 Q. So does the drain hole aid in the drying of  
16 the barber's tools, cleaned barber tools?

17 A. I think the word is it is a prerequisite for  
18 the drying of those tools.

19 Q. Do you see a distinction there?

20 Well, do you see a distinction between  
21 being a prerequisite for drying the tools and aiding  
22 in the drying of the tools?

23 A. I think so.

24 I mean, if you said, "aid," I guess in

Dr. Samir Nayfeh August 26, 2005

98

1 cleaning fluid container within the agreed  
2 construction of the parties?

3 MS. WENDLANDT: Objection.

4 A. Yes.

5 Q. And is it your understanding that that spray  
6 can would have been similar to the -- is it your  
7 understanding that the spray can that Dr. Pahl  
8 procured would be similar to the spray can 60 of the  
9 Loeffler patent?

10 MS. WENDLANDT: Objection.

11 A. I can't say.

12 Q. You also note with respect to the spray can  
13 in 60 of the Loeffler patent, in the last sentence,  
14 you state, "As is clear from Figure 1 of the Loeffler  
15 patent reproduced immediately above, there is no  
16 provision to catch or contain the contaminated fluid  
17 that would drain from the shaving head in a fluidic  
18 cleaning operation."

19 Do you see that?

20 A. Yes.

21 Q. Can you point me to where in the language of  
22 Claim 14 there is any requirement of a provision to  
23 catch or contain contaminated fluid?

24 A. It's only implied.

Dr. Samir Nayfeh August 26, 2005

99

1 Q. And implied within the construction of  
2 cleaning fluid container?

3 A. Yes. And possibly elsewhere. Yeah. It's  
4 implied when you say "cleaning fluid."

5 Q. Let me ask you this: You're aware that  
6 Rayovac sells its product with a bottle of cleaning  
7 fluid; is that correct?

8 A. Yes.

9 Q. And is that bottle of cleaning fluid a  
10 cleaning fluid container?

11 A. Yes.

12 Q. And you are also aware that the fluid is  
13 poured out of that bottle into Rayovac's device,  
14 correct?

15 A. Correct.

16 Q. And you're also aware that the contaminated  
17 fluid is not poured back into that bottle; is that  
18 correct?

19 MS. WENDLANDT: Objection.

20 A. It could be, but probably not. You wouldn't  
21 expect to.

22 Q. So, let me ask, also, as well: They sell  
23 detergent for mops, for cleaning dishes and perhaps a  
24 floor in containers; is that correct? Are you aware

Dr. Samir Nayfeh August 26, 2005

100

1 of those?

2 A. Correct.

3 Q. And are those cleaning fluid containers, a  
4 bottle of dishwasher detergent?

5 A. Yes.

6 Q. Do people return the dishwasher detergent to  
7 the bottle after the detergent has been used for  
8 cleaning?

9 MS. WENDLANDT: Objection.

10 A. No.

11 Q. Could you look at the feed device element,  
12 Part 11 of your report?

13 A. Yes.

14 Q. You opine that the feed device element is not  
15 met by the Loeffler patent?

16 A. Yes.

17 Q. You also state that valve 75 is a flow  
18 control device?

19 A. Yes.

20 Q. What is the difference between a feed device  
21 and a flow control device?

22 A. So the feed device, as we mentioned,  
23 exemplified by the pump and conduits, and possibly  
24 other components, includes that thing which provides



Dr. Samir Nayfeh August 26, 2005

128

1 connection with the prosecution of the '328 patent  
2 disclose a bracket for insertion of a shaving  
3 apparatus therein?

4 A. I don't know. I really only addressed the  
5 ones that were raised by Mr. Phillips.

6 Q. Okay. And at the bottom of Page 21, you  
7 state, "More importantly, even if Mr. Zeischke had  
8 drawn a bracket into which the electronic shaver  
9 could be inserted for storage and charging, this  
10 would not have taught a bracket into which the shaver  
11 could be inserted during cleaning."

12 Do you see that?

13 A. Yes.

14 Q. Where in Claim 18 of the '328 patent is there  
15 a requirement that the shaver has to be inserted into  
16 the bracket during cleaning? And, again, I am  
17 emphasizing "during cleaning" part of the statement.

18 A. So, again, it's not literally there, but  
19 clearly from the specification when the bracket is  
20 described, it's -- the bracket is -- you insert into  
21 the bracket during the cleaning operation.

22 Q. Above that, in the paragraph above that, you  
23 note that the rectangles, which I think are called  
24 park positions, serve only to indicate the general

Dr. Samir Nayfeh August 26, 2005

192

1 ports.

2 Q. So fluid does not go from the cleaning fluid  
3 container to the supporting surfaces 3C directly; is  
4 that correct?

5 A. As we discussed, it is shot into, or at, at  
6 least, the shaving head, and then makes it way down  
7 there and possibly gets those wet.

8 MR. SHIMOTA: Why don't we take a brief  
9 break.

10 THE VIDEOGRAPHER: Going off the record.  
11 The time is 3:37.

12 (A recess was taken.)

13 THE VIDEOGRAPHER: One moment. We are  
14 back on the record. The time is 3:46.

15 Q. We were talking a little bit about  
16 infringement.

17 I know you offered opinions with respect  
18 to literal infringement; is that correct?

19 A. You might want to clarify what you mean.

20 Q. Sure. Are you familiar with the term the  
21 "doctrine of equivalence"? Have you ever encountered  
22 that before?

23 A. I have read about it a bit, but I haven't  
24 done any detailed opinions on that.

Dr. Samir Nayfeh August 26, 2005

193

1 Q. So I take it you have not offered any  
2 opinions that Rayovac's devices infringe under the  
3 doctrine of equivalence; is that correct?

4 A. I don't think so.

5 Q. In your reports, do you offer any -- well, do  
6 you offer any opinion, assuming that the court  
7 modifies its "cradle structure" construction as  
8 suggested by Mr. Phillips and now Rayovac?

9 MS. WENDLANDT: Opinion as to?

10 Q. Opinion as to infringing -- infringement --  
11 let me rephrase that question.

12 In your reports, is there any opinion  
13 offered as to whether or not Rayovac's devices  
14 infringe, if the court's "cradle" construction is  
15 modified as suggested by Mr. Phillips?

16 A. The only modification being to require  
17 receive and retain?

18 Q. Yes.

19 A. I don't think I have offered an opinion on  
20 that, as I recall.

21 Q. Okay. So that opinion would not be found in  
22 either your first or your third expert report?

23 A. I don't think so.

24 Q. Okay.

Dr. Samir Nayfeh August 26, 2005

194

1 MR. SHIMOTA: I would like to mark  
2 Defendant's Exhibit 165, your third expert report.

3 EXHIBIT NO. 165 MARKED

4 Q. And most specifically to Page 13, when you  
5 talk about the substitutes.

6 MS. WENDLANDT: Just to clarify for the  
7 record, mine has Jesse Davies report as well.

8 Should we take that out?

9 MR. SHIMOTA: Yes.

10 MS. WENDLANDT: Is that Page 62 of the  
11 fax?

12 MR. SHIMOTA: Yes. We can do that. I'm  
13 not going to ask you about it. We can do it off the  
14 record. I guarantee you I won't ask you about that,  
15 because I haven't read it closely.

16 Q. What is your -- what is the analytical  
17 framework you applied for assessing whether  
18 noninfringing -- acceptable noninfringing substitutes  
19 were available to Rayovac?

20 A. I really just responded to what Mr. Phillips  
21 had written.

22 Q. Okay. I am focusing on -- you make the  
23 statement, and you have a prelude paragraph, and you  
24 state, at the last sentence, "Or more importantly, at

Dr. Samir Nayfeh August 26, 2005

195

1 the time it began making its first infringing devices  
2 in the fall of 2003."

3 Do you see that?

4 A. Yes.

5 Q. Why do you think that fact is  
6 significant?

7 A. Well, just my understanding that that the  
8 substitutes would have had to have been available at  
9 the time that the infringement occurred.

10 Q. Okay. Do you understand that in assessing  
11 whether substitutes would be available you are to  
12 assume that Rayovac knew that it wouldn't be able to  
13 sell devices as are currently configured? Rayovac  
14 had that information available to it?

15 A. We would assume that Rayovac knew that it was  
16 infringing on a valid patent.

17 Q. Knew that it could not --

18 A. Okay. Uhm, I didn't know that.

19 Q. Okay. You refer to on Page 14 a passive  
20 drying. Do you see that?

21 A. Right.

22 Q. I believe you state, "There is no reason to  
23 believe" -- at the end of the first paragraph --  
24 "Therefore, it would be acceptable to consumers now."

Dr. Samir Nayfeh August 26, 2005

221

1 A. I don't recall seeing any such report.

2 Q. You can't comment on what you have not seen?

3 A. Yes. Yes.

4 Q. If you heard about it, maybe you could.

5 One last question. Are you aware that

6 Mr. Phillips opines upon, how it referred to, as

7 secondary considerations of nonobviousness in his

8 report?

9 A. I seem to recall that, yes.

10 Q. Am I correct that you do not offer any

11 opinions on secondary considerations of

12 nonobviousness, right?

13 A. I don't recall having done so.

14 At most, I might have quoted somebody. I

15 don't recall giving any opinions on that.

16 Q. I mean, can you say one way or the other

17 whether you have?

18 A. To be definitive, I would have to read --

19 MS. WENDLANDT: Jim, we can stipulate

20 that if it is not in the report, he hasn't opined on

21 it, or he can sit here and read it.

22 Q. I don't want you to read it.

23 A. I could be proven wrong, because I have

24 thought about these issues, but I don't recall